

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UATP IP LLC,
Petitioner,

v.

SLICK SLIDE LLC,
Patent Owner.

PGR2024-00054
Patent 11,998,854 B1

Before MITCHELL G. WEATHERLY, KRISTINA M. KALAN, and
BRIAN D. RANGE, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.223(a)

I. INTRODUCTION

UATP IP, LLC ("Petitioner") filed a Petition to institute post-grant review of claims 1–17 and 22–28 of U.S. Patent No. 12,998,854 B1 (Ex. 1001, "the '854 patent"). Paper 2 ("Petition" or "Pet."). We instituted trial on April 8, 2025. Paper 8 ("Inst. Dec."). On May 8, 2025, the Board received an e-mail from Petitioner requesting authorization to file a motion

to submit supplemental information under 37 C.F.R. § 42.223(a).¹ Ex. 3002. On May 9, 2025, we authorized Petitioner to file a motion to submit supplemental information and Slick Slide LLC (“Patent Owner”) to file an opposition thereto. *Id.*

Petitioner moves to submit supplemental information under 37 C.F.R. § 42.223(a). Paper 13 (“Mot.”). Patent Owner opposes. Paper 14 (“Opp.”). The supplemental information consists of a Supplemental Declaration of Dr. Youjiang Wang (Ex. 1043) and associated Exhibits 1039–1042. For the reasons set forth below, we grant Petitioner’s Motion.

II. ANALYSIS

After trial has been instituted, a party may file a motion to submit supplemental information under 37 C.F.R. § 42.223(a) if: (1) the request for authorization to file the motion is made within one month of the date the trial is instituted; and (2) the supplemental information is relevant to a claim for which trial has been instituted. Satisfying the two elements of Rule 223(a), however, does not guarantee the granting of the motion. Rather, the Federal Circuit has instructed us that the “guiding principle” in making any determination, including whether to grant a motion to submit supplemental information, is to “ensure efficient administration of the Office and the ability of the Office to complete [the proceeding] in a timely manner.” *Redline Detection LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015).

¹ Petitioner inadvertently cites 37 C.F.R. § 42.123(a), filing of supplemental information after institution of *inter partes* review, instead of the corresponding applicable section for post-grant review, 37 C.F.R. § 42.223(a). Ex. 3002, 1; Mot. 1, 3–4.

A. 37 C.F.R. § 42.223(a)

As the moving party, Petitioner bears the burden of proof that it is entitled to the relief requested in the motion. 37 C.F.R. § 42.20(c).

Petitioner asserts, and we agree, that its motion satisfies the timeliness requirement of Rule 223(a)(1) because it requested authorization to file its motion within one month of institution. Mot. 1, 3–4 (noting the Board instituted trial on April 8 and Petitioner made its request on May 8). Petitioner further asserts that its motion satisfies Rule 223(a)(2) because the proposed supplemental information is relevant to the claims for which trial has been instituted. *Id.* According to Petitioner, Exhibit 1043 (citing Exhibits 1039–1042 therein) provides further supplemental testimony via the supplemental declaration for issues addressed by Patent Owner in its Preliminary Response or by the Board in the Decision on Institution. *Id.* at 1 (citing Inst. Dec. 32).

We instituted trial of all claims and on all grounds asserted in the Petition; however, in order to provide the parties with insight into the Board’s analysis of all grounds, we determined that the Petition, supported by the preliminary record, had failed to persuade us of a reasonable likelihood of prevailing with respect to some of the asserted claims and grounds. *See generally* Inst. Dec. In particular, we focused our analysis of Petitioner’s enablement challenge of claims 8–13 on Dr. Wang’s original statements in Exhibit 1003:

After considering the parties’ arguments and evidence, we have concerns about the sufficiency of Petitioner’s showing relating to enablement of claim 8. Petitioner’s assertion that commercial epoxies suggested in the ’854 patent for use in the dry lubricant composition would not provide a frictional coefficient between 0.03 and 0.06 is unsupported. *See* Pet. 88.

Dr. Wang's assertion on this issue is conclusory, and although he recognizes that those commercial epoxies include silicon or PTFE, he does not address their coefficients of friction. Ex. 1003 ¶ 285. Similarly, his assertion that a person of ordinary skill would have been unable to achieve the claimed range by increasing the amount of lubricant or adding copper, based on the '854 patent's suggestion, is unsupported. *Id.* ¶ 287. Further, he does not address, for example, what experimentation a person of ordinary skill would undertake in adjusting the composition to achieve a desired coefficient of friction, and whether it would be routine or undue experimentation. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) (factor number 1). Nor does he address the predictability or unpredictability of the art. *See id.* (factor number 7). On this record, Dr. Wang's statements do not adequately support Petitioner's enablement argument.

Inst. Dec. 32. We encouraged the parties to fully develop the record during trial to facilitate the resolution of the fact-intensive disputes. *Id.* at 40.

In response, Petitioner filed its Motion, seeking to submit Exhibit 1043, a Supplemental Declaration of Dr. Youjiang Wang, to "offer[] testimony address[ing] positions already taken in the Petition and his prior declaration." Mot. 5. According to Petitioner, in the Supplemental Declaration, Dr. Wang "offers discussion of three academic papers that provide information related to what a person of ordinary skill would have understood about the coefficients of friction and other properties of epoxies containing lubricant materials at the time of filing of the '854 patent," providing context for "Patent Owner's [lack of enablement] arguments that the commercial epoxies mentioned in the '854 patent would themselves reach the lowest claimed range of frictional coefficients and that a [skilled artisan] would have simply determined the amount of lubricant to add to a commercial epoxy to reach the lowest claimed coefficient of friction range of 0.03-0.06." Mot. 3, 5–6.

With respect to the second requirement of Rule 42.223(a), information is relevant if “it has any tendency to make a fact more or less probable than it would be without the evidence” and “the fact is of consequence in determining the action.” Fed. R. Evid. 401; *see also* 37 C.F.R. § 42.62 (“Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to a proceeding.”). The Petition relies on Mr. Wang’s declaration. Pet., *passim*. Thus, Mr. Wang’s supplemental testimony is relevant to a claim for which trial has been instituted.

We find, and Patent Owner does not dispute, that Exhibits 1039–1043 are relevant to the challenged claims, for which this trial was instituted. *See* 37 C.F.R. § 42.223(a)(2).

B. Additional Considerations

In evaluating a motion to submit supplemental information, we are cognizant that “the introduction of new evidence in the course of the trial is to be expected” during post-grant review trial proceedings, and “as long as the opposing party is given notice of the evidence and an opportunity to respond to it, the introduction of such evidence is perfectly permissible.” *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016); *see also id.* at 1367 (stating the purpose of the trial in a post-grant review proceeding “is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware”). The requirements of 37 C.F.R. § 42.223 clearly contemplate scenarios in which, after institution of trial in a post-grant review, supplemental information may prove beneficial to the Board in reaching a decision with respect to the trial. In promulgating the rule, the Board was cognizant of concerns that may arise due to a belated

request to submit supplemental information in establishing an “interests-of-justice” standard in such a circumstance; however, there is no such standard for requests that are presented within one month of the date trial being instituted. *See* 37 C.F.R. § 42.223; *see also* 77 Fed. Reg. 48,707, Comment 91 (Aug. 14, 2012).

On the other hand, the opportunity to submit supplemental information does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition. Thus, we consider whether admission of the supplemental information would change the grounds initially presented in the petition or otherwise unfairly change the evidence underlying those grounds. We also consider whether a patent owner would be unduly prejudiced in having to respond to the supplemental information, if permitted.

Petitioner asserts that the supplemental information does not change the grounds or evidence of unpatentability in this proceeding. Pet. 4–6.

According to Patent Owner, in submitting Exhibits 1039–1043, “Petitioner’s Motion represents a clear ‘wait-and-see’ approach, using the POPR and the Institution Decision as a roadmap to cure deficiencies that should have been addressed at the time of filing.” *Id.* at 1; *see also id.* at 2–3, 5 (the same). Patent Owner argues that Dr. Wang’s Supplemental Declaration “does not simply clarify earlier opinions but offers new declaratory evidence concerning (1) what a POSITA would understand about commercial epoxies and the claimed COF range, and (2) whether achieving the claimed COF range would be simple and routine.” Opp. 4. Patent Owner contends “the issues were plainly foreseeable and should have been addressed in the Petition.” *Id.*

Patent Owner argues that the motion should be denied because Petitioner “offers no explanation as to why this supplemental evidence could not have been included with the original Petition.” Opp. 4. In *Redline Detection*, the Federal Circuit ruled that whether supplemental information reasonably could not have been submitted with the petition is a factor that may be considered in evaluating a motion to submit the supplemental information, but did not require the petitioner to demonstrate the supplemental information sought to be submitted could not have been submitted with the petition in every instance under Rule 42.223(a). *Redline Detection*, 811 F.3d at 443–45. Here, we find that Petitioner should not have been expected to anticipate the abovementioned statements made in the Institution Decision when the Petition was filed. *See* Inst. Dec. 32. Thus, we do not find Patent Owner’s argument persuasive in this instance.

Petitioner contends that its Motion is consistent with the efficient administration of the proceeding and the ability of the Board to complete the proceeding in a timely manner, as required by *Redline Detection*. Mot. 5.

Petitioner also notes that Patent Owner will have sufficient time to address the supplemental information before filing its Patent Owner Response.² *Id.* at 5.

Having considered Petitioner’s arguments and the proposed supplemental information in Exhibits 1039–1043, we find Petitioner’s Motion is timely and that the supplemental information is relevant to Ground 3A on which trial has been instituted, thereby satisfying the requirements of Rule 223(a)(1) and (2). Moreover, we find that granting the

² The Parties agreed to modify Due Date 1, Patent Owner’s response to the petition, from July 1, 2025 to September 15, 2025. Paper 18, 1.

Motion comports with our guiding principles of efficiency for the reasons stated by Petitioner. *See* Mot. 5–6; *see also* Paper 16, 1.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s motion for leave to file a Supplemental Declaration of Dr. Youjiang Wang (Ex. 1043) and associated Exhibits 1039–1042 is *granted*;

FURTHER ORDERED that Exhibits 1039–1043 be, and hereby are, entered into the record;

FURTHER ORDERED that, at Patent Owner’s option, Petitioner shall make Dr. Wang available for a second deposition of up to two hours on or before December 8, 2025, which deposition shall be limited to cross examination of Dr. Wang on the subject matter set forth in Exhibit 1043; and

FURTHER ORDERED that, the word count limit for the Patent Owner Response is expanded to 20,700 words.

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PETITIONER:

W. Karl Renner
Thomas A. Rozylowicz
Craig A. Deutsch
Kiersten M. Batzli
FISH & RICHARDSON P.C.
axf-ptab@fr.com
tar@fr.com
deutsch@fr.com
batzli@fr.com

PATENT OWNER:

Brett A. Schatz
Louis H. Sitler
WOOD, HERRON & EVANS LLP
bschatz@whe-law.com
lsitler@whe-law.com